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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,336	12/17/1999	VINCENT CHING PING LI		8784

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EXAMINER

DYE, RENA

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/465,336

Applicant(s)

LI ET AL.

Examiner

Rena L. Dye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 24-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Introduction*

1. In view of Applicant's arguments regarding the restriction requirement, the Examiner has repeated the restriction requirement, with added changes, for further clarification.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to a method for monitoring for a user the price activities of a financial instrument traded in a financial market, *classified in class 705, subclass 37*;
  - II. Claim 24-42, drawn to an apparatus of charting price movements in a financial market, *classified in class 345, subclass 440*.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand. Although cumbersome, the claimed price activities could be plotted by hand, such as by (a) plotting a plurality of bars on a price-time chart; (b) employing a bar from the chart and building a frequency distribution; (c) deriving a set of discrete intra-market elements from the frequency distribution; (d) representing each element of

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the set of intra-market elements by a first geometric figure, and overlaying the first geometric figure onto the bar; and (e) displaying the overlaid price-time chart to the user.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their *different classification*, restriction for examination purposes as indicated is proper.

5. Applicant's election with traverse of Group I, Claims 1-23 in Paper No. 6 is acknowledged. The traversal is on the grounds that the Examiner has not at least met the showing of a serious burden. Examiner has not for example cited patents to support the statement that there are distinct inventions that "have acquired a separate status in the art because of their recognized divergent matter." This is not found persuasive because, the Examiner has shown for the record that the claimed inventions are distinct, and that the inventions have a separate classification as evidenced by the above noted classifications of the method and apparatus groups. In view of the above listed classifications, Applicant's arguments regarding MPEP § 808.02 no longer apply. Refer to US Patents 6,272,474 and 5,581,677 cited with this action.

Applicant's arguments regarding that the Examiner has not met the showing of a serious burden is not convincing. MPEP § 803 states that Examiner must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. For purposes of the initial requirement, a serious burden on the

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examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. A *prima facie* showing may be rebutted by appropriate showings or evidence by the application.

In view of the above, the restriction requirement is proper and further maintained.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-23 show a series of steps which are grounded in the abstract idea of, for example, plotting, employing, deriving, representing, graphically representing, taking, determining, and allowing.

The broadly recited steps do not recite sufficient computer structure that are within “technological arts”. Therefore, they do not satisfy the statutory requirements of 35 USC 101. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

The claims require changes to fix this issue. For example, Claim 1 could be re-written, for example, so that the plotting step read -- plotting a plurality of bars on a price-time hart by a processor .... --.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, In particular, Claim 1: a two-dimensional price-time bar chart, with the Y-coordinate representing price and X-coordinate representing time, with the X-axis divided into a plurality of discrete intervals, each interval

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having a bar associated with it must be shown or the features canceled from the claims. All claimed features should be shown in the drawings. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, limitation “(b) employing a bar...” is vague and unclear. How is Applicant *employing* a bar within the scope of the invention. Clarification is requested. How is Applicant employing..? Is this done by a computer or physically by hand?

In claim 1, the limitation “(c) deriving a set of discrete intra-market elements” is unclear. Clarification is requested. How is Applicant *deriving* elements?

In claim 1, the limitation “(d) representing each element of said set of intra-market elements...” is vague. How is Applicant *representing...*”?

In claim 16, the limitation “(a),(b) calculating a mean price of the price distribution” is unclear. Is the *calculating* done by a computer or by hand? Clarification is requested.

In claim 16, the limitation “(c) defining said continuous price range” is unclear. How is Applicant *defining...*”?

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In claims 22-23, the expression “allowing the user to select/define” is unclear. As recited, “allowing” can refer to or include a thought process. How is Applicant allowing the user to *select/define*?

As claimed, Applicant’s invention can be performed by hand. The process steps should be amended so that the steps are performed with sufficient computer structure so that the invention falls within the “technological arts.”

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia (US 6,272,474).

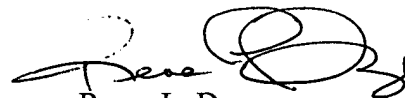
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Garcia teaches plotting of bars on a price-time chart (two-dimensional), with the Y-coordinate representing price and X-coordinate representing time. As can be best understood by the Examiner the claimed invention is taught by Garcia.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday-Thursday 8:30 AM - 7:0 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Rena L. Dye  
Primary Examiner  
Art Unit 3627

R. Dye  
January 13, 2003